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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RABAGO, ROBERTO

ART UNIT

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1796

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 07/728,428	Applicant(s) CANICH, JO ANN M.	
	Examiner Roberto Rábago	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,44-52,54-56,60-74,77-87,99,105-124 and 126-132 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27,45-47,64-66,68,70,71,77,78,80,81,105-113,115,116 and 122 is/are allowed.
- 6) ☒ Claim(s) 48-52,54-56,60-63,69,72-74,79,82-87,114,117-121,123,124 and 126-132 is/are rejected.
- 7) ☒ Claim(s) 44,67 and 99 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 44, 67, 74, 99, 117 and 121 are objected to for the following reasons.
 - (a) All limitations of claim 44 are already present in the parent claim, and therefore is of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
 - (b) In claim 67, "provided that" is repeated in the line seventh from the end.
 - (c) In claim 74, "diethylmethylene" is duplicated in the line third from the end.
 - (d) In claim 99, "y is 1" is duplicated in the line fifth from the end; either "y is 1" or "when y is 1" should be deleted.
 - (e) Claim 117 should end with a period instead of a comma.
 - (f) In claim 121, in the description of R, parameter X should be in lower case for correspondence with the structure.

Claim Rejections - 35 USC § 112

2. Claims 48-52, 54-56, 60-63, 69, 72-74, 83-87, 114, 117-120, 121, 123, 124, 126, 128 and 131 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(a) In claim 48 (and claims 49-52, 54, 55, 60-63, 79, 82, 83-87, 123, 124, and 126 as dependent thereon), no support exists for R being cyano.

(b) In claim 48 (and claims 49-52, 54-56, 60-63, 83-87, 123, 124, and 126 as dependent thereon), no support exists for the description of X and T, starting from "30 carbon atoms" in the line ninth from the end, and continuing through the penultimate line. It appears that applicants have copied this passage directly from the prior interference count; however, this portion of the count appears to have been based only upon the opponent's claims. In winning the interference, applicants were awarded entitlement to their own claims which corresponded to the count, but not to subject matter disclosed only in the opponent's claims.

(c) In claim 49, no support exists for X having "up to 30 carbon atoms".

(d) No support exists for the content of claims 55, 126 and 128.

(e) In claim 69, no support exists for Q being any hydrocarbyl; the specification provides only for C1-C20 hydrocarbyl.

(f) In claim 72 (and claims 79 and 82 as dependent thereon), no support exists for T being any substituted methylene or ethylene.

(g) In claim 73, no support exists for R being any of ethyl, propyl, butyl, octyl, benzyl, phenyl, trimethylstannyl, triethylplumbyl, or trifluoromethyl.

(h) In claim 73, no support exists for Q being any of methylphenoxy, diethylamido, dibutylamido, dipropylamido, or diethylphosphido.

(i) In claim 74, no support exists for R being any of ethyl, propyl, butyl, octyl, benzyl, phenyl, trimethylstannyl, triethylplumbyl, or trifluoromethyl.

(j) In claim 74, no support exists for Q being any of methylphenoxy, diethylamido, dibutylamido, dipropylamido, or diethylphosphido.

(k) In claim 114, no support exists for Q being diethylphosphide.

(l) In claim 117 (and claims 118 and 119 as dependent thereon), no support exists for R being any of ethyl, propyl, butyl, octyl, benzyl, phenyl, trimethylstannyl, triethylplumbyl, or trifluoromethyl.

(m) In claim 117 (and claims 118 and 119 as dependent thereon), no support exists for Q being any of methylphenoxy, diethylamido, dibutylamido, dipropylamido, or diethylphosphido.

(n) In claim 120, no support exists for this particular set of ligands being bonded to titanium metal.

(o) In claim 121, no support exists for R being any substituted C1-C20 hydrocarbyl radical. Furthermore, no support exists for the substitution being any of an amido radical, a phosphido radical, an alkoxy radical, or any other radical containing Lewis acidic or basic functionality. Furthermore, no support exists for the R being any of an amido radical, a phosphido radical, an alkoxy radical, an alkylborido radical or a radical containing Lewis acidic or basic functionality.

(p) In claim 121, no support exists for R' being any of an amido radical, a phosphido radical, an alkoxy radical, or a radical containing Lewis acidic or basic functionality.

(q) In claims 124 and 131, no support exists for R' being any of the stated structures. It appears that applicants have inadvertently indicated the structures as corresponding to R', while the specification indicates that they should correspond to the entire (JR'_{z-2}) moiety (see Table 1).

3. Claims 127-132 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 127-132 are indefinite because they depend from cancelled claim 88.

Double Patenting

4. Claims 73 and 74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,621,126 and its Reissue patent RE37,788. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate or render obvious the instant claims, and vice-versa. The patented claims set forth substantially the same compound as instant claim 73, the only substantive difference being in the definition of R', wherein the patented claims recite that R' is a C1-C20 (US '126) or C3-C20 (RE '788) aliphatic or alicyclic hydrocarbon bonded to nitrogen through a 1° or 2° carbon atom, whereas the instant claim recites specific species. However, selection of the patented species from those recited in claim 73 would be obvious

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because 6 of the recited selections, among a total of 15 species, are C1-C20 aliphatic or alicyclic hydrocarbon bonded to nitrogen through a 1° or 2° carbon atom, amounting to a selection of 1 in 3. Selection from such a small group is anticipatory, and therefore allegations of unexpected results will not overcome this rejection. Claim 74 is analogous to claim 73, except that the scope of bridge moieties is further restricted. However, selection of a methylene bridge would be obvious in view of patented claim 6, wherein T is stated to be CR³R⁴, wherein R³ and R⁴ may be hydrogen, resulting in the simplest selection within the stated scope.

Regarding the applicability of US '126, applicants cannot avoid a double patenting rejection over this reference merely because it has been reissued as RE '788. The courts have addressed the issue of the propriety of an obviousness-type double patenting rejection over a non-pending patent in several cases. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001), footnote 5, wherein the Court stated that a "patent owner cannot avoid double patenting by disclaiming the earlier patent." See also *Ex parte Crissy, Spano, and Wolff*, 201 USPQ 689, 692 (Bd. Pat. App. & Inter. 1976) where a reference patent was held to be available for double patenting in a situation where the reference patent had "lapsed" failure to pay the balance of the issue fee. See also *Ex parte Morimoto*, 18 USPQ 1540 (Bd. Pat. App. & Inter. 1990) where the reference patent claims that had been canceled from the reference patent via reexamination certificate were held to be available for double patenting (where those claims had been re-presented in the application before the Board). In each case, disclaimed, lapsed or otherwise non-pending patented claims

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have been held to be available as a reference in an obviousness-type double patenting rejection.

Applicants are advised that should claim 124 be amended to recite that the stated groups correspond to the (JR'_{z-2}) moiety, then claims 124 will also be rejected over this reference.

5. Claims 27, 45-47, 64-66, 68, 70, 71, 77, 78, 80, 81, 105-113, 115, 116 and 122 are allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/
Primary Examiner
Art Unit 1796

RR
October 8, 2008